

Docket AUS920010253US1

Appl. No.: 09/925,585
Filing Date: 08/09/2001**REMARKS**

This is a reply to a first Office action in which claims 1-14 are rejected under 35 USC 101 and claims 1-21 are rejected under 35 USC 103(a).

Attorney England wishes to thank Examiner Patel for his courtesy in discussing a draft of this reply that Attorney England submitted informally. In that telephone conversation, which was on 11/10/2005, Examiner Patel and Attorney England agreed that the amendments submitted herein overcome the rejections under 35 USC 101. (The arguments below regarding 35 USC 101 issues are submitted for the record.) Since Examiner Patel indicated he would strongly prefer to discuss the prior art rejections when he takes up the case pursuant to the present reply, Attorney England agreed to submit a separate, written request for a telephone interview as a reminder for Examiner Patel to schedule the interview at his convenience.

Applicant contends the Office action improperly rejects claims 1-7 under 35 USC 101. Nevertheless, Applicant herein submits an amendment to more certainly ensure claim 1 and its dependent claims define statutory subject matter. Applicant also herein submits an amendment to claim 8 so that it and its dependent claims define statutory subject matter.

Applicant also herein submits amendments to claims 1, 8 and 15 and cancels claims 2-3, 9-10 and 16-17 to overcome the rejections under 35 USC 103(a). Applicant herein cancels dependent claims 2-3, 9-10 and 16-17 and amends dependent claims 4, 5, 7, 11, 12, 14, and 18-21 to conform to amended independent claims 1, 8 and 15.

1. The Office action improperly rejects claims 1-7 under 35 USC 101.

The Office action rejects claims 1-7 under 35 USC 101 on the basis that the language of the claims “raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful and tangible result” (emphasis added). However, the initial burden is on the USPTO to present a prima facie case of unpatentability. Manual of Patent Examining Procedure, 8th edition, revision 3, 2106, II.A., (August 2005) (“Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare Musgrave, 431 F.2d at 893, 167 USPQ at 289; In re Foster, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when

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such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection."); see also; Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Section IV.B., page 16 (October 26, 2005) ("The burden is on the USPTO to set forth a prima facie case of unpatentability."); see also, id., Section IV.D., page 24 (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)).

Simply raising a question as to whether claims define statutory subject matter does not present a prima facie case of unpatentability. First, a reason must be set forth explaining grounds for the conclusion that claims are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful and tangible result. See, Manual of Patent Examining Procedure, 8th edition, revision 3, 2106, VII., (August 2005) ("The Office action should clearly communicate the findings, conclusions and reasons which support them."); see also, Interim Guidelines, Section IV.B., page 16 ("... the examiner must provide an explanation."); see also, id., Section IV.D., page 24 ("After the examiner identifies and explains in the record the basis for why a claim is for an abstract idea with no practical application, then the burden shifts to the applicant to either amend the claim or make a showing of why the claim is eligible for patent protection. See, e.g., *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995); see generally MPEP § 2107 (Utility Guidelines."). Second, recent guidance indicates a "more likely than not" standard applies, so that even with an explanation of reasons for a question as to whether claims define statutory subject matter, the question must rise beyond the level of mere existence. See, id., Section IV.B., page 16 ("... if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories ..."); see also, id., Section IV.D., page 24 ("If the record as a whole suggests that it is more likely than not that the claimed invention would be considered a practical application of an abstract idea, natural phenomenon, or law of nature, the examiner should not reject the claim."). The Office action does not apply the law to the facts of the present application in such a way as to give an explanation of the grounds for rejection. Instead, the Office action simply states the law. Moreover, the Office action does not even contend it is more likely than not that the claims fail to define statutory subject matter.

2. Despite the foregoing, Applicant herein submits an amendment to claim 1.

Because a prima facie case of unpatentability has not be established, Applicant is under no obligation to respond. Nevertheless, Applicant herein submits an amendment to claim 1 for

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the sake of cooperation and to expedite an allowance. The amendment more certainly ensures claim 1 and its dependent claims define statutory subject matter.

Specifically, claim 1 is amended herein to include limitations in a fashion even more explicit than that of originally submitted apparatus claim 15, which was not rejected under 35 USC 101. In particular, amended claim 1 states that the method includes "storing a survey document on a computer-readable medium of a first computer system . . . for delivery over a network to a second computer system." Also, claim 1 is amended herein to state that the method includes "storing programming instructions on a computer-readable medium of the first computer system . . . for delivery over the network to the second computer system."

No new matter is added in the amendments to claim 1 described immediately above, since the specification as originally submitted provides support. Present application, FIG. 1 and page 5 , lines 6-17 (regarding first computer 110, second computer 150 and storage unit 115); see also, page 11, line 18 - page 12, line 1 (regarding examples of computer-readable storage medium).

Further, claim 1 is amended herein to even more particularly state a useful, concrete and tangible result, by stating that in the method for generating a survey for a computer system on a network, "the survey document [has] questions and answers in a certain format for delivery over a network to a second computer system," and stating that the survey document is "for presenting ones of the survey document questions and answers for selecting by a user of the second computer, wherein according to the certain format of the survey document, the questions and answers are defined as data elements included in the survey document as strings of text surrounded by text markups, including tags describing the data elements and attributes defining associations among the questions and answers, including associations such that ones of the questions branch from ones of the answers."

No new matter is added in the amendments to claim 1 described immediately above, since the specification as originally submitted provides support. Present application, page 6 , lines 7-9 (regarding the survey document having questions and answers in a certain format for delivery over a network to a second computer system); FIG. 8 and page 10 , line 20 - page 11, line 17 (regarding presenting ones of the survey document questions and answers for selecting by a user of the second computer); page 6 , lines 9-15, FIG. 2 and page 7, line 6 - page 8, line 14

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(regarding the data elements including attributes defining associations among the questions and answers, including associations such that ones of the questions branch from ones of the answers).

Even further, claim 1 is also amended herein to state that the programming instructions stored "for delivery over the network to the second computer system, includ[e] instructions for causing the second computer system to parse the data elements from the survey document into data arrays having cross-references defining the associations among questions and answers, and instructions for causing the second computer system to display on a user interface certain ones of the questions, including the first one of the questions, and branch to and display on the user interface the second and third ones of the questions, or else not branch to and display the second and third ones of the questions, responsive to an answer selected by the user and received by the second computer system for the first question and responsive to ones of the cross-references defining the associations among the first, second and third one of the questions."

No new matter is added in the amendments to claim 1 described immediately above, since the specification as originally submitted provides support. Present application, page 5 , line 18 - page 6, line 5, and page 6, lines 17-19, FIG. 3, FIG. 8, and page 10, line 20 - page 11, line 7 (regarding instructions for causing the second computer system to parse the data elements from the survey document into data arrays having cross-references defining the associations among questions and answers); page 11 , lines 8-18, and FIG's 3-7, page 8, line 15 - page 10, line 19, FIG. 8, and page 11, lines 8-18 (regarding instructions for causing the second computer system to display on a user interface certain ones of the questions, including the first one of the questions, and branch to and display on the user interface the second and third ones of the questions, or else not branch to and display the second and third ones of the questions, responsive to an answer selected by the user and received by the second computer system for the first question and responsive to ones of the cross-references defining the associations among the first, second and third one of the questions).

3. Applicant herein amends independent claim 8 to overcome the rejection of the claim and its dependent claims under 35 USC 101.

The Office action rejects claims 8-14 under 35 USC 101 on the basis that the language of the computer program product claims fail to include a computer readable medium. Applicant

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herein submits an amendment to claim 8 to include a computer readable medium, as suggested, so that claim 8 and its dependent claims define statutory subject matter.

No new matter is added in the amendments to claim 8, since the specification as originally submitted provides support. Present application, FIG. 1 and page 5, lines 6-17 (regarding first computer 110, second computer 150 and storage unit 115); page 11, line 18 - page 12, line 1 (regarding examples of computer-readable storage medium).

4. Applicant herein amends independent claims 1, 8 and 15 to overcome the rejection of the claims and their dependent claims under 35 USC 103(a).

The Office action rejects claims 1, 8 and 15 under 35 USC 103(a) as being unpatentable over US Pub. 2002/0029154 ("Majoor") in view of US Pub. 2002/0119433 ("Callendar"). The Office action rejects claims 2, 4, 7, 9, 11, 14, 16, and 21 under 35 USC 103(a) as being unpatentable over Majoor in view of Callendar further in view of US Pub. 2002/0184265 ("Gupta"). The Office action rejects claims 3, 5-6, 10, 12-13, and 17-20 under 35 USC 103(a) as being unpatentable over Majoor in view of Callendar further in view of US Pub. 2002/0184265 ("Gupta").

The cited art teaches that it is known to display different sets of next questions responsive to different answers. Callender, paragraph 0041; Majoor, paragraph 0024. The cited art teaches that it is known to define a database of test questions and answers in an XML format. Gupta, paragraphs 0060-0116. The cited art teaches that it is known to parse an XML document with a parsing tool, such as Java Application Programming Interface for XML Parsing ("JAXP"). Gupta, paragraph 0021. The cited art teaches that it is known for a survey results server to provide survey results to a client. Plantec, FIG. 9, col. 37, lines 1-10. This may include the server accessing an HTML file associated with a survey report, and processing script instructions referenced therein for extracting data for the survey, wherein questions and answers are stored in question and answer arrays. Plantec, FIG. 9, col. 38, lines 33-48. However, Applicant contends that because the cited art does not teach or suggest what is claimed, the rejections under 35 USC 103(a) are overcome by amendments submitted herein to independent claims 1, 8 and 15, wherein all the elements, steps or limitations of claims 2-3, 9-10 and 16-17 are incorporated into their respective independent claims, and wherein further limitations are also added. No new

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matter is added by these amendments, since the specification as originally submitted provides support, as explained herein above regarding claim 1.

A. The references do not teach or suggest that a survey document has data elements with the particularly claimed attributes of the present invention.

Amended claim 1, for example, states that "the questions and answers are defined as data elements included in the survey document as strings of text surrounded by text markups, wherein the data elements include tags describing the data elements and attributes defining associations among the questions and answers, including associations such that ones of the questions branch from ones of the answers . . ." Claims 8 and 15 have similar language, each according to the respective forms of the invention they claim. The cited references do not teach or suggest this.

B. The references do not teach or suggest a first computer storing, for delivery to a second computer, a survey document for presenting questions for a user of the second computer to select and instructions for parsing the survey document.

Amended claim 1, for example, states that a method for generating a survey for a computer system on a network includes ". . . storing a survey document on . . . a first computer system . . . having questions and answers . . . for delivery over a network to a second computer system and for presenting ones of the survey document questions and answers for selecting by a user of the second computer . . . and storing programming instructions . . . of the first computer system . . . for delivery over the network to the second computer system," where the programming instructions include "instructions for causing the second computer system to parse the data elements from the survey document into data arrays having cross-references." Claims 8 and 15 have similar language, each according to the respective forms of the invention they claim. The cited references do not teach or suggest this.

C. The references do not teach or suggest storing instructions on the first computer for delivery to the second computer, where the instructions cause the second computer to branch or not branch to questions in the particularly claimed manner of the present invention.

Amended claim 1 further states that the programming instructions, which are stored on the first computer for delivery to the second computer, include "instructions for causing the second computer system to parse the data elements from the survey document into data arrays

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having cross-references defining the associations among questions and answers, and instructions for causing the second computer system to display on a user interface certain ones of the questions, including the first one of the questions, and branch to and display on the user interface the second and third ones of the questions, or else not branch to and display the second and third ones of the questions, responsive to an answer selected by the user and received by the second computer system for the first question and responsive to ones of the cross-references defining the associations among the first, second and third one of the questions." Claims 8 and 15 have similar language, each according to the respective forms of the invention they claim. The cited references do not teach or suggest this.

D. No proper motivation or suggestion has been shown for the combination of the cited references.

It is important to rely on objective evidence and make specific factual findings with respect to the motivation to combine references. MPEP 2143.01 (citing *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)). Regarding the teachings of the prior art, the teachings must do more than merely show all aspects of the claimed invention were individually known in the art. MPEP 2143.01 (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993), and indicating there must be an objective reason to combine the teachings of the references). Regarding the nature of the problem to be solved, such motivation might exist in the nature of the problem to be solved if each reference is directed "to precisely the same problem." MPEP 2143.01 (citing *In Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, at 1276 (Fed. Cir. 2004)). Regarding the knowledge of persons of ordinary skill in the art, it has been held that without a finding about a "specific understanding or principle within the knowledge of the skilled artisan" that would have provided a motivation combine the teachings, alleged knowledge of persons of ordinary skill in the art provided no motivation to combine. MPEP 2143.01 (citing *In re Kotzab*, 217 F.3d 1365, at 1370-1371, (Fed. Cir. 2000)).

It is unclear which source of motivation the Office action contends is applicable to the posited combination of the references. Certainly, all the references relied upon are not directed

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to precisely the same problem as that of the present invention. The Office action cites no objective reason or specific understanding or principle within the knowledge of the skilled artisan taught by the cited references that would have provided a motivation to combine their teachings. The cited references merely show that certain limited aspects, but not all aspects, of the claimed invention were individually known in the art, and do not provide objective reasons for combining their teachings.

5. Applicant herein cancels and amends other claims.

Applicant herein cancels dependent claims 2-3, 9-10 and 16-17 and amends dependent claims 4, 5, 7, 11, 12, 14, and 18-21 to conform to amended independent claims 1, 8 and 15. No new matter is added by these amendments, since the specification as originally submitted provides support, as explained herein above regarding claim 1.

PRIOR ART OF RECORD

Applicant has reviewed the prior art of record cited by but not relied upon by Examiner, and asserts that the invention is patentably distinct.

REQUESTED ACTION

Applicant hereby requests the following actions:

1. For the above reasons, Applicant contends the invention defined in claims 1, 8 and 15 is patentably distinct. Further, claims 4-7, 11-14, and 18-21 are allowable at least because they depend on respectively allowable independent claims. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Applicant requests that Examiner grant allowance and prompt passage of the application to issuance.

2. It should be understood Applicant is at a disadvantage because the present Office action does not identify features of the invention that would render the claimed subject matter statutory if recited in originally submitted claims 1-7. That is, since claims 15-20 are held to define statutory subject matter, it appears the invention as set forth in the written description is

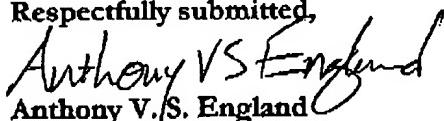
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statutory. Recent guidance clarifies that the Office action should, therefore, identify features of the invention that would render the claimed subject matter statutory if recited in claims 1-7. See, id., Section IV.B., page 16 ("If the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, USPTO personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. § 101, but identify the features of the invention that would render the claimed subject matter statutory if recited in the claim."). The Office action does not identify such features for claims 1-7. For this reason, in addition to the reasons set forth above regarding failure to present a prima facie case of unpatentability, Applicant contends that if the rejection of claims 1-7 under 35 USC 101 are maintained, it would be improper for the rejections to be final.

3. Applicant encourages the Examiner to contact Attorney England if needed.

Respectfully submitted,


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